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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/545,238	04/07/2000	Hideki Nishimoto	0941.63875	2032

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EXAMINER

ORTIZ CRIADO, JORGE L

ART UNIT	PAPER NUMBER
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2655

13

DATE MAILED: 04/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/545,238

Applicant(s)

NISHIMOTO ET AL.

Examiner

Jorge L Ortiz-Criado

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12/06/2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 and 26 is/are pending in the application.
- 4a) Of the above claim(s) 4 and 8 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-7 and 26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12/06/2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>9.10</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-3, 5-7 and 26 are rejected under 35 U.S.C. 102(e) as being anticipated by Morimoto U.S. Patent No. 6,226,257.

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention “by another,” or by an appropriate showing under 37 CFR 1.131.

Regarding claim 1, Morimoto discloses an optical recording medium comprising:
a substrate having a land and a groove alternately arranged in a predetermined direction (See col. 3, lines 28-38 Fig. 9, #98,100);

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a data recording region provided on the land and the groove (See col. 3, lines 28-38; Fig. 9, re#98,100); and

an identification mark recording region provided on only one of the land and the groove and recorded with a data block identification mark which indicates a start identification information for identifying a data block (See Fig. 9, #112),

said data block being formed by the data block identification mark, the identification information and the data recording region (See col. 9 lines 6-56; Fig. 9, #112,102/104,100,98)

Regarding claim 2, Morimoto discloses wherein the data block identification mark is made of a projecting part formed on the groove and having approximately the same height as the land or, made of a cavity part formed on the land and having approximately the same depth as the groove (See Figs. 2,9)

Regarding claim 3, Morimoto discloses a first identification information recording region recorded with identification information for identifying the data block of the data recording region on the land (See col. 9 lines 6-56; Fig. 9, #104); and

a second identification information recording region recorded with identification information for identifying the data block of the data recording region on the groove (See col. 9 lines 6-56; Fig. 9, # 102),

said identification mark recording region being provided in only one of the of the first identification information recording region and the second identification recording

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region at a position preceding the identification information (See col. 9 lines 6-56; Fig. 9, #112,102/104)

Regarding claim 5, Morimoto discloses wherein information for identifying the data recording region is recorded by a magneto-optical recording ("If the optical disk has a land/groove servings both as recording tracks and it's a rewritable optical disk such as magneto-optical disk and phase-change optical disks, the information its inherently magneto-optically recorded"; See col. 1, lines 6-25)

Regarding claim 6, Morimoto discloses wherein a width of the projecting part forming the data block identification mark is greater than or equal to a width of the land, and a width of the cavity part forming the data block identification mark is greater than or equal to a width of the groove (See Fig, 9-#114)

Regarding claim 7, Morimoto discloses wherein a depth of the groove forming the data recording region is different from a height of the projecting part and a depth of the cavity part which form the data block identification mark (See col. 6, lines 12-28; col. 7, lines 44-51; Figs. 2,3,9)

Regarding claim 26, Morimoto discloses an optical disk comprising:

a substrate having a land and a groove alternately arranged in a radial direction (See col. 3, lines 28-38 Fig. 9, #98,100);

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a data recording region, provided on the land and the groove, to record data (See col. 3, lines 28-38; Fig. 9, re#98,100); and

an sector mark recording region provided, provided on only one of the land and the groove, and recorded with a sector mark which indicates a start identification information for identifying a data block (See Fig. 9, #112),

said data block being formed by the sector mark, the identification information and the data recording region (See col. 9 lines 6-56; Fig. 9, #112,102/104,100,98)

Response to Arguments

3. Applicant's arguments with regard the election/restriction requirement.

Applicants argued that claims 1-8 area readable on the elected Species and the Examiner withdrew claims 4 and 8 from consideration, without comments

The Examiner cannot concur because as cited in the prior action claims 4 and 8 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected Species. Claims 4 and 8 are drawn to the Species of Figures 11A-11C.

Election was made **without** traverse in Paper No. 7, filed 9/20/2003.

4. Applicant's arguments with respect to claims 1-3, 5-7 and 26 have been considered but are moot in view of the new ground(s) of rejection.

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Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jorge L Ortiz-Criado whose telephone number is (703) 305-8323. The examiner can normally be reached on Mon.-Thu.(8:30 am - 6:00 pm),Alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Doris H To can be reached on (703) 305-4827. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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A handwritten signature in black ink, appearing to read 'Doris H. To', with a stylized flourish at the end.

DORIS H. TO
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600